UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ANDERSON, FOLASHADE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/699,419	KUMAR ET AL.
	Examiner	Art Unit	
	FOLASHADE ANDERSON	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>09 June 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) <u>8-15 and 21-23</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7 and 16-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>12/02/2003</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This is the first non-final office action in response to Applicant's submission filed

on May 12, 2008. Currently, claims 1-23 are pending. Claims 8-15 and 21-23 have

withdrawn from consideration.

Election/Restrictions

2.   Applicant's election of group I in the reply filed on May 12, 2008 is

acknowledged. Because applicant did not distinctly and specifically point out the

supposed errors in the restriction requirement, the election has been treated as an

election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on December 2, 2003 was

considered by the Examiner in the prosecution of the claims in the instant application.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

5.   Claims 1-7 are In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps, as in claim 1. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-7 are non-statutory since they may be preformed within the human mind.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7.   Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 recites "**optionally changing the business rules and applying the**

changed business rules during execution of the workflow" It is unclear if the step

itself is optional or if the user is given the option to create and apply a business rule.

For purposes of examination the step is interpreted to mean creating and applying a

business rule

Claims 2-7 which depend from claim 1 suffer similar deficiencies.   Correction is

required.

Claim 2 recites "**pre-defined progression of operations**".   In light of the

specification it is unclear what is encompassed in this phrase.   For purposes of

examination the step is interpreted to mean a predetermined map of operational steps.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 1-5, 7 and 16-20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Gleason (2003/0195762 A1).

Claim 1

Gleason teaches **a method of tracking operations in an automated business**

process, the method comprising:

* **defining a plurality of operations at a plurality of nodes in a business**

    process (0003, the invention features a workflow method including

    specifying data source, invoking a decision-tree based map using icons

    that represent elements of business rules 0013 a map representing a

    business process flow with input and output, a start and end activity

    destination, activity assignments, and a rule set linked to each of the

    activity assignments, and 0022, users of the system are able to define a

    process and associate the responsible parties, where the Examiner

understands a node to be a connection point in a process for example those of the decision tree);

- **executing a workflow comprising the operations** (0010 executing the selected activities (operations) and 0017 system enables the execution of business process application (operations));

- **applying a plurality of business rules to the workflow at the nodes to affect the operations** (0019 web service is a rule or action within a rule that interacts within an external system via the web, for the purpose of querying and retrieving a response from an external system, which response is the input to the next rule or activity within the business process);

- **optionally changing the business rules and applying the changed business rules during execution of the workflow** (0025 individual rules and sets of rules that are configurable by the use of variables assigned and 0022 the user can generate a set of variables that in addition to being one output of the application, can control decisions and flow of the business process thus making the process dynamic and adaptive to external business conditions, where the Examiner understands dynamic to indicate a continuous action i.e. during execution); **and**

- **providing a correlation between the business rules applied to the nodes and the corresponding affected operations to track operations within the workflow** (0003 linking input from the input and output forms to

dynamic variables within the decision-tree based map and 0007 tracking a

status of the business process).

Claim 2

Gleason teaches **the method of claim 1, wherein executing a workflow**

comprises executing a pre-defined progression of operations (0017 a decision tree

based process map), **wherein the operations are at least one of transactions**

internal to a business enterprise and transactions external to a business

enterprise (0068 applications that input or amend data on an interactive basis before

arriving at the final values, such as budgeting (transaction), where the Examiner

understands that it was old and well known in the art at the time the invention was made

that budgeting was a transaction type that could have been preformed either internal or

external to an enterprise. Further the Examiner understands that within a workflow

process a transaction can only be either internal or external and therefore any reference

to a workflow process with the step of executing would read on this claim).

Claim 3

Gleason teaches **the method of claim 1, wherein the operations comprise**

passing XML formatted messages according to the workflow (0028 business

process management engine to access a Microsoft COM.RTM (Component Object

Model) through the use of a SOAP (Simple Object Access Protocol)/XML (eXtensible

Mark up Language) services and 0048 Any client application capable of generating an

HTML request that complies with the SOAP standard, and that conforms to a request

layout described in WSDL file, can use SOAP services as a way of communicating with

the process engine, where the Examiner understand that the process engine executes the workflow process 0011).

Claim 4

Gleason teaches **the method of claim 1, wherein applying a plurality of business rules to the workflow comprises using a rules engine integrated with a workflow processor** (0011) the application server including a process engine for executing an automated work flow process and 0082 the process engine provides a process designer and the handles the generation and editing of business process and process rule sets. The process engine provides a process manager that handles running or scheduling of business processes)

Claim 5

Gleason teaches **the method of claim 1, wherein optionally changing the business rules and applying the changed business rules during execution of the workflow comprises implementing a changed business rule while avoiding at least one of suspending, recompiling and redeploying the workflow** (0068, The COM layer additionally provides a local cache capability for the API information. Performance is improved as any information already returned from a server based process engine remains available locally at the client. The cache layer can persist itself to disk and therefore a client application can be coded to continue working while disconnected from the process engine. Method calls are provided in the COM layer to allow the cache to be refreshed from the process engine and so reflect any updated information.)

Claim 7

Gleason teaches **the method of claim 1, wherein providing a correlation between the business rules applied to the nodes and corresponding affected operations comprises providing a correspondence between a specific business rule executed at a node and a resultant state of an operation within the workflow of the automated business process** (0082 the process engine provides monitoring of the progress of active processes and displaying log information for processes that have run, where the Examiner understands that it was old and well known in the art at the time the invention was made that a log would contain the status and results of an operations step)

Claim 16

Claim 16 is substantially similar to claim 1 and is therefore rejected for substantially the same reasoning given above with regards to claim 1.

Claim 17

Claim 17 is substantially similar to claim 3 and is therefore rejected for substantially the same reasoning given above with regards to claim 3.

Claim 18

Claim 18 is substantially similar to claim 4 and is therefore rejected for substantially the same reasoning given above with regards to claim 4.

Claim 19

Claim 19 is substantially similar to claim 5 and is therefore rejected for substantially the same reasoning given above with regards to claim 5.

Claim 20

Claim 20 is substantially similar to claim 7 and is therefore rejected for substantially the same reasoning given above with regards to claim 7.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gleason (US Publication 2003/0195762 A1) in view of Agarwal et al (An operational Approach to the design of workflow systems, published 2000).

Claim 6

Gleason teaches **The method of claim 1, wherein optionally changing the business rules and applying the changed business rules during execution of the workflow** (0022 and 0025). Further Gleason teaches a decision tree based process map (0017) commonly associated with if/then type of program at the time the invention was made; however Gleason does not expressly teach **utilizing at least one declarative if/then statement.**

Agarwal teaches **utilizing at least one declarative if/then statement** (pg. 550 If the test result is false then an approval activity. If the result of the test is true the

approval is skipped. Class 'if' representing decisions that can be automatically taken by the workflow enactment service) in an analogous art for the purpose of modeling the workflow system (abstract)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Agarwal in the invention of Gleason to allow for the ease of non-technical person's understanding and management of the process structure (Agarwal, 554).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

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